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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/248,524	02/09/1999	AMIT R. SHAH	2870/72	8887

7590 03/23/2004

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EXAMINER

WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/248,524

**Applicant(s)**

SHAH, AMIT R.

**Examiner**

Lauren Q Wells

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

Claims 1-22 are pending. The Amendment filed 11/24/03, amended claims 1, 10, and 19.

The Amendment to claims 1, 10, and 19 is persuasive to overcome the 35 USC 112 rejection over the term “derived” the previous Office Action. Applicant’s arguments and page 5, lines 25-30, of the instant specification, are persuasive to overcome the 35 USC 112 rejection over the term “long-wearing” in the instant claims.

### ***103 Rejection Maintained***

The rejection of claims 1-15, 17, 19-22 under 35 U.S.C. 103(a) as being unpatentable over Valdes et al. (4,761,277) in view of Alwattari et al. (5,874,072) is MAINTAINED for the reasons set forth in the Office Action mailed 7/24/03, and those found below.

The rejection of claims 16 and 18 under 35 U.S.C. 103(a) as being unpatentable over Valdes et al. (4,761,277) in view of Alwattari et al. (5,874,072), as applied to claims claims 1-15, 17, 19-22 above, and further in view of Burdzy (5,518,728) is MAINTAINED for the reasons set forth in the Office Action mailed 7/24/03, and those found below.

Applicant argues, “because the polymers from each of the references are not interchangeable when considering that the polymer in the ‘277 reference is a water soluble polymer combined with polyvinyl alcohol and the polymer taken from the ‘072 reference to be added to the ‘277 compositions is water insoluble. Thus, one of ordinary skill in the art would not make the substitution contemplated by the Examiner”. This argument is not persuasive. The Examiner respectfully points out that the instant rejection does not contemplate substituting a water insoluble polymer for a water soluble polymer. The instant rejection adds the water insoluble polymer of Alwattari et al. to the composition comprising a water soluble polymer of

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Valdes et al., see the 35 USC 103 rejection in the previous Office action, because Alwattari et al. teach that the addition of a water insoluble polymer, such as ammonium acrylate, to water soluble film-forming polymers, such as those taught by Valdes et al., results in compositions that have superior wear and that are removable with soap and water.

Regarding Burdzy, Applicant argues, “There is no indication that any of the forms are intended to be interchangeable as the list includes lipsticks and lip liners, powder products, and crème blushes”. This argument is not persuasive. Burdzy teaches that cosmetic compositions for application to the skin can comprise many forms, wherein he teaches eyeliners and lipliners as acceptable cosmetic forms, wherein such forms are equivalent for applying compositions to the skin. It is additionally respectfully pointed out that substituting one cosmetic form for another of a given composition, especially two stick forms, is well established in the art.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

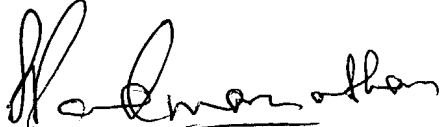
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**